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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,888	07/08/2003	Terence Gerard Daly	10407-631	9852

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EXAMINER	
BROCKETTI, JULIE K	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,888	DALY, TERENCE GERARD	
	Examiner	Art Unit	
	Julie K. Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05192005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-8, 10-12, 15-17, 20-23, 25-27, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Munoz, U.S. Patent Application Publication No. 2004/024313 A1. Munoz discloses a gaming method for playing a reel selection slot machine. A plurality of reels within a display window are spun. The plurality of reels each display one or more game symbols (See Munoz Fig. 3). A subset of the spinning reels is selected for use in determining a game outcome. The non-selected reels are removed from a player's view within the display reel. The selected reels are consolidated in the display window so as to be rearranged so that the selected reels are adjacent to one another. It is then determined if the selected reels produce a winning game outcome and a prize is awarded if a winning game outcome is achieved (See Munoz Fig. 4; ¶0022, ¶0028-¶0030) [claims 1, 16, 30]. The spinning of

the reels are stopped after the consolidating of the selected reels within the display window (See Munoz ¶0004, ¶0028) [claims 2, 17]. The consolidating of the selected reels within the display window includes juxtapositioning the selected reels to eliminate any non-contiguous positioning of the selected reels produced by the removal of the non-selected reels (See Munoz Figs. 4-6) [claims 5, 20, 30]. The selection of the subset of reels for use in determining a game outcome is player controlled (See Munoz ¶0028) [claims 6, 21]. The selection of the subset of reels for use in determining a game outcome is computer controlled (See Munoz ¶0031) [claims 7, 22]. The plurality of reels are video representations of physical reels (See Fig 3) [claims 8, 23]. The gaming method is used as a bonus game in conjunction with an underlying primary game (See Munoz ¶0033) [claims 10, 25]. A winning outcome in the bonus game results in a prize that is added to a prize won in the underlying primary game or a multiplying prize won in the underlying primary game (See Munoz ¶0005) [claims 11, 12, 26, 27]. For example, if a player gets a 2 x multiplier, this "doubles" the primary prize, i.e. it adds the primary prize to itself. The gaming method may be used as a primary game (See Munoz ¶0004) [claims 15, 30].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz, U.S. Patent Application Publication No. 2004/024313 A1. Munoz discloses stopping the spinning of the reels after consolidating the selected reels within the display window. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to stop the spinning of the selected reels before consolidating the selected reels or before removing the non-selected reels from a player's view within the display window because Applicant has not disclosed that the time the reels are stopped provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Munoz's gaming device and applicant's invention to perform equally well with stopping the spinning of the reels at any time because no matter when the reels are stopped, the player still gets to view the game outcome. Therefore, it would have been prima facie obvious to modify Munoz to obtain the invention as specified in claims 3, 4, 18 and 19 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Nash.

Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of the Price is Right game "Squeeze Play". Munoz lacks in disclosing randomly changing the position of the

selected reels after removing the non-selected reels. In the Price is Right game "Squeeze Play" a contestant, randomly chooses one number out of three numbers to be removed from the price of a prize. Once that number is removed, the remaining numbers randomly change positions, i.e. based on the contestant's random selection of the removed number, and the remaining numbers remain and are compared to the price of the prize and it is determined if the contestant wins (See "Squeeze Play") [claims 9, 24]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to randomly change the position of the selected reels after removing the non-selected reels in the game of Munoz. By changing the reel positions, the player can clearly see which reels are still involved in the play of the game and can concentrate on these reels instead of reels not involved in the game outcome.

Claims 13, 14, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Fier, U.S. Patent No. 6,126,542. Munoz lacks in disclosing that the bonus game reduces or loses a prize in the underlying primary game. Fier teaches of a gaming device and describes in the background of the invention how it is common throughout the art that when a non-winning game outcome occurs in the bonus game, there is the possibility of losing or reducing a prize won in the underlying primary game (See Fier 2 lines 16-26) [claims 13, 14, 28, 29]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the player

risk their primary game award when in order to play the bonus game. By having the player risk their primary award, the casino can recoup the primary award if the player loses the bonus game. Therefore, by having the player risk their primary award the casino can make money in order to pay off the bonus games with winning outcomes.

Response to Amendment

It has been noted that claims 5-7 and 20-22 have been amended.

Response to Arguments

Applicant's arguments filed August 4, 2005 have been fully considered but they are not persuasive.

Applicant argues that Munoz lacks in disclosing, "selecting a subset of the spinning reels". That is all of the reels are spun and then a subset of those reels is selected. Applicant argues that Munoz merely discloses a method in which the player selects the active reels and then the active reels are spun. The Examiner disagrees and notes that giving the claims their broadest reasonable interpretation; Munoz does anticipate the claim language through a variety of interpretations. In looking at claim 1 as an example it states, "spinning a plurality of reels within a display window, the plurality of reels each displaying one or more game symbols". Munoz clearly discloses spinning all five reels in the display window in one spin of the game. For example, the

game machine may spin all of the reels. Claim 1 then goes on to state, "selecting a subset of the spinning reels for use in determining a game outcome". In Munoz a player may select to have only 3 reels determine the game outcome; thereby, selecting a subset of the spinning reels for use in determining a game outcome. For example, a player may have all five reels spin in one play of the game machine and then after that play is over, the player or computer may select to have only three reels active for a second play of the game machine. Therefore, one can call the reels that the player selects "spinning" reels since they were spinning in a previous play of the game machine. The Examiner notes that nothing in Applicant's claims clearly limit the selection of "the spinning reels" to occur while the reels are actually spinning or even in one play of the game machine. One could read the claim as having the player/computer select the reels once they are stopped as long as the reels are "capable of spinning". Furthermore, in support of this argument, the Examiner states in claim 1 "determining if the selected reels produce a winning game outcome" but nothing in the claim states that the reels stopped spinning, it is just assumed that the reels have stopped spinning in order to determine the outcome; just as one can interpret "the spinning reels" as merely capable of spinning and not spinning at the time the player/computer selects them.

The Examiner notes that another interpretation of Munoz reads on Applicant's independent claims. In Munoz, the player/computer can select

three reels for use in determining a game outcome. When a player selects these three reels, all of the reels are "spinning reels" in that the three reels that are to form the game outcome, spin as normal and the unselected reels, i.e. deactivated reels spin into a predetermined position to indicate that the reels have been deactivated (See Munoz ¶0028). Therefore, all of the reels can be considered to be "spinning reels". For example, in Munoz, the player/computer may select a subset of the spinning reels for use in determining a game outcome and then the plurality of reels may spin. The Examiner further notes that or a reference to anticipate the claims the order in which the method steps are performed does not matter. The court held in *In re Donaldson 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)* that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order. Consequently, the Examiner notes that the order of Applicant's method claims is irrelevant. The reels may be selected before they are spun just as in Munoz. The Examiner further notes that Applicant's open-ended claim language by using the phrase "comprising" allows for the reference to encompass other steps not claimed by Applicant. The Examiner also notes that even if one could argue that Munoz does not qualify under 35 USC 102 as anticipating Applicant's claim language based on the fact that in Applicant's invention, the player/computer selects the reels

while they are spinning in one play of the game this is merely a design choice under 35 USC 103 in that Applicant has not disclosed that selecting the reels while they are spinning provides an advantage, is used for a particular purpose, or solves a stated problem.

Applicant disagrees with the Examiner's characterization of the Price is Right "Squeeze Play" game. Applicant argues that the remaining numbers do not randomly change position because once a randomly selected number is removed; the order of the remaining numbers is not altered. The Examiner agrees that the first number does not change position however; the other numbers do randomly change positions. For example if the display is 48036, and the player randomly removes the "8", the new number is 4036 so the "0", "3" and "6" have all changed positions, i.e. moved up one position.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brocketti whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julie Brocketti

Julie K Brocketti
Primary Examiner
Art Unit 3713